

**REMARKS**

Upon entry of the present Amendment, the claims in the application are claims 2, 4, 6, 8, and 9-23.

**ELECTIONS/RESTRICTIONS**

Affirmation of the 12/7/2005 provisional election is hereby made.

**CLAIM REJECTIONS – 35 USC § 112**

The claims have been amended to comply with 35 USC §112.

**CLAIM REJECTIONS – 35 USC § 102**

The last OA rejects claims 2 and 4 under 35 USC 102(b) as being anticipated by Stoetzel U.S. Patent 250,998.

Applicant respectfully traverses this rejection based on the following.

It is respectfully submitted that all elements of the claimed invention must be identically described in a single prior art reference for anticipation. Scripps Clinic & Research Foundation v Genentech, Inc., 927 F2d 1565, 18 USPQ 2d 1001 (Fed Cir. 1991).

Furthermore, applicant respectfully submits that anticipation must be established by the literal presence of each recited claim element in a single prior art reference, and novelty is not defeated except by literal disclosure of each element.

Amended claim 2 requires “pivot means releasably connected to both of said cross members pivoting said elongated workpiece about a horizontal axis within said substantially rectangular frame structure”.

The last OA alleges that "Stoetzel discloses a portable adjustable jig featuring...A pivot means (seen as projection between ends i, i<sup>2</sup>)." Underscoring added for emphasis.

Applicant respectfully submits that Stoetzel does not disclose, or mention, or show any pivot means, nor disclose the unidentified and unmentioned projection as having any specific function.

Furthermore, it is respectfully submitted that the last OA concedes this by stating: "The pivot means is seen as the center protrusion on cross member H. Stoetzel does not specifically disclose this protrusion to be a pivot means, or to have any specific function."

Because the last OA concedes that Stoetzel does not specifically disclose applicant's pivot means, applicant can only speculate whether or not the last OA is alleging that Stoetzel inherently discloses applicant's claimed pivot means, especially in view of the statement in the last OA that a "reference is still anticipatory if it explicitly or inherently discloses every limitation recited in the claims."

Applicant respectfully submits that under the Doctrine of Inherency, if applicant's claimed pivot means is not expressly disclosed in Stoetzel, then Stoetzel may still be deemed to anticipate only if:

- (1) the pivot means is necessarily present in Stoetzel; and
- (2) the pivot means would be so recognized by persons of ordinary skill.

Under the Doctrine of Inherency, if an element is not expressly disclosed in a prior art reference, the reference can only be deemed to anticipate if the missing element "is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v Monsanto Co.*, 948 Fed 2d 1264, 1268, 20 USPQ 2d 1746, 1749 (Fed Cir 1991).

In addition, "Inherent anticipation requires that the missing material is 'necessarily present' not merely probably or possibly present in the prior art." *Trintic Industries Inc. v Top-USA Corp.*, 295 Fed 3d, 1292, 1295, 63 USPQ 2d, 1597, 1599 (Fed Cir 2002) (quoting *in re Robertson*, 169 Fed 3d 743,745, 49 USPQ 2d 1949, 1950-51 (Fed Cir 1999)).

Notwithstanding the foregoing, the last OA alleges that "It is clear" that the protrusion (which is not even mentioned anywhere in Stoetzel, and is not even identified by a reference numeral in the Stoetzel drawings) would be capable of performing the function of pivot means. The last OA immediately follows this allegation by "Applicant is referred to *In re Schoenwald*, wherein it has been decided, 'No utility need be disclosed for a reference to be anticipatory...' (22USPQ2d 1673))".

In contrast, applicant respectfully submits that the ruling in *Schoenwald* applies to chemical cases, and not to mechanical cases.

Furthermore, it is noteworthy that the *Schoenwald* statement quoted in the last OA conveniently omits the remainder of the full quote which should read, "no utility need be disclosed for a reference to be anticipatory of a claim to an old compound." *In re Schoenwald*, 964 Fed 2d 1122, 1124 (Fed Cir 1992).

In addition, applicant respectfully submits that Stoetzel does not enable a person of ordinary skill in the field to make the portable workstation as specified in amended claims 2 and 4 without undue experimentation. Applicant respectfully submits that a 35 USC 102 reference must enable without undue experimentation. *Elan Pharm., Inc. v Mayo Foundation for Medical and Education Research*, 346 Fed 3d 1051, 1054 (Fed. Cir 2003).

It should also be noted that amended claim 2 requires "pivot means releasably connected to both of said cross members pivoting said elongated workpiece about a horizontal axis within said substantially rectangular frame structure." Underscoring added for emphasis.

It is respectfully submitted that Stoetzel fails to disclose expressly or under the doctrine of inherency that the unidentified and unmentioned Stoetzel protrusion is "releasably connected to both of said cross structures", or is used for "pivoting said workpiece". Indeed, the last OA concedes that Stoetzel does not specifically disclose the unidentified, unmentioned protrusion to be a pivot means, or to have any specific function.

Also, it is respectfully submitted that Stoetzel does not even mention any workpiece, or any workpiece which is pivoted within a frame structure about a substantially horizontal axis, or any workpiece which is stabilized within a frame structure when said workpiece is being worked upon, all of which are required by applicant's amended claims.

The last OA also states that Stoetzel discloses a portable adjustable jig featuring a stabilizing means (opposite complementing projection between  $i$ ,  $i^2$ ). The last OA further states that the stabilizing means "is seen as" the complementary pivot point, and "It is clear" that the complementary pivot would stabilize a workpiece in a horizontal orientation. Applicant respectfully traverses this.

Applicant's traversal hereinabove with respect to the pivot means is incorporated herein by reference thereto with respect to Stoetzel's alleged stabilizing means.

Here again, the opposite complementing projection, which is neither mentioned nor identified by Stoetzel, is not a complementary pivot point, and there is no express or implied use of such projections to pivot or stabilize a workpiece in a horizontal orientation.

In addition, the alleged opposite projections of Stoetzel could not be used to pivot a workpiece in view of the interference of Stoetzel's intermediate crossbars  $B^2$ ,  $B^3$ . See Stoetzel Fig. 10. Here again, a 35 USC 102 reference must enable without undue experimentation. See Elan Pharm, Inc., cited above.

Furthermore, applicant respectfully submits that Stoetzel fails to disclose expressly or inherently, any means for pivoting any workpiece within a frame structure about a horizontal axis, nor any stabilizing means releasably connected to only one of said cross member stabilizing the workpiece within the frame structure when the workpiece is being worked upon, nor such stabilizing means located a fixed distance from such horizontal axis, all of which are required by amended claims 2 and 4.

In light of the foregoing, applicant respectfully requests reconsideration of the 35 USC 102 rejection with a view toward withdrawing same.

#### **CLAIM REJECTIONS – 35 USC §103**

The last OA rejects claims 6, 8-12 and 21-23 under 35 USC 103(a) as being unpatentable over Stoetzel alone. Applicant respectfully traverses this rejection.

Applicant incorporates herein by reference thereto all of the arguments, distinctions and authorities set forth hereinabove with regard to the 35 USC 102 rejection.

In addition, the last OA concedes that the legs disclosed by Stoetzel are not orthogonally affixed to the frame.

However, the last OA alleges that to have an orthogonal arrangement, the brace (E) would need to be shortened. Applicant respectfully traverses this.

Applicant respectfully submits that Stoetzel alone does not disclose or make obvious the features of the amended claims.

While the last OA concedes that the legs disclosed by Stoetzel are not orthogonally affixed to the frame, the last OA proceeds to reengineer the Stoetzel apparatus in attempt to make out a case of obviousness. In particular, the last OA states that to have an orthogonal arrangement, the brace (E) would have to be shortened.

In contrast, applicant respectfully submits that merely shortening the brace (E) would not make obvious the features recited in applicant's claims. It should be noted that Stoetzel folding legs D, D' are pivoted at their upper ends on a rod b which in turn is secured at its ends to the side pieces B and B'.

Thus, it is not a case of merely shortening brace E, but rather it would be necessary to precisely reengineer brace E so that it would result in an orthogonal arrangement, and this would still not result in an "adjustable" angle support as required by applicant's claims, nor an arrangement which is "releasably" connectible at its upper end to the external object being supported, nor to a "side member" of such external object.

In light of the foregoing, applicant respectfully submits that Stoetzel would not be an enabling reference without undue experimentation, including the additional elimination of the rod b which forms a pivoting arrangement for the folding legs D, D'.

The last OA also alleges that the motivation to keep the legs directly under the frame would be to prevent a person from tripping over the legs. Applicant respectfully traverses this.

Applicant respectfully submits that the legs of the Stoetzel arrangement as disclosed are within an upper extending perimeter of a structure which as disclosed prevents a person from tripping over the legs.

The last OA also alleges that applicant has not disclosed any "surprising results" favored by the orthogonal arrangement. Applicant respectfully submits that "surprising results" are not a prerequisite for patentable subject matter.

In light of the foregoing, applicant respectfully requests reconsideration of the 35 USC rejection, with a view toward withdrawing same.

COMMENTS

Page 6 of the last OA includes a paragraph entitled "Comments" which follows the 102 and 103 rejections. It is not clear from the last OA whether such paragraph should have been included in the 102 and 103 rejections, and if so, whether or not applicant should address this paragraph, nor whether or not this paragraph relates to the 102 rejection or the 103 rejection.

To err on the side of caution, applicant will nevertheless address such paragraph.

The last OA comments that "it is clear" from the figures of Stoetzel that an elongated object such as a pipe or tube would pivot without hindrance on "the described pivot point". First, there is no "described pivot point". Second, it would appear from this comment that the last OA is contending that an elongated object such as a pipe or tube constitutes the "workpiece" recited in applicant's claims.

Following this line of reasoning, Stoetzel would disclose (but does not) stabilizing means stabilizing the workpiece when the workpiece is being worked upon, because the alleged pipe or tube would pivot if one were to follow the reasonings of the comment.

However, Stoetzel does not expressly or inherently disclose any pivot point or stabilizing means. In this connection, the arguments, distinctions and citations set forth hereinabove with regard to alleged means for pivoting the workpiece and alleged stabilizing means for stabilizing the workpiece while it is being worked upon, are incorporated herein by reference thereto.

Furthermore, the last OA does concede that it is also clear that an elongated workpiece with a significant width, such as a door, would not be able to pivot due to obstruction from cross bars B<sup>2</sup> and B<sup>3</sup>.

The Comments in the last OA refer the applicant to MPEP §2.144.04 (IIA), where it is stated "Omission of an element and its function is obvious if the function of the element is not desired".

Applicant respectfully submits that this section of the MPEP does not apply in the present situation.

Furthermore, applicant makes reference to MPEP §2.144.04 (IIIB) where it is stated "Omission of an element with intention of the element's function is an indicia of unobviousness." Underscoring added for emphasis.

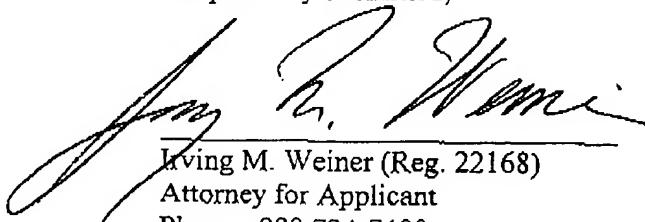
If the Comments in the last OA are intended to mean that the Stoetzel crossbars B<sup>2</sup> and B<sup>3</sup> give "additional stability", then it should be noted that applicant obtains its "additional stability" by the adjustable squaring mechanism (claim 4) and/or the pair of angled support mechanisms (claims 6 and 8), and/or the adjustable angled support member (claim 9 and the claims dependent therefrom), and/or the adjustable angled support member (claims 21 and 23).

In view of the foregoing, applicant respectfully submits that the application is now in condition for allowance, and a notice to this effect is earnestly solicited.

In the event that the Examiner is not yet convinced that the application is now in condition for allowance, then it is respectfully requested that the Examiner promptly telephone the undersigned attorney for applicant in an effort to facilitate the prosecution, and/or to narrow the issues for appeal, if necessary.

Favorable consideration is respectfully requested.

Respectfully submitted,

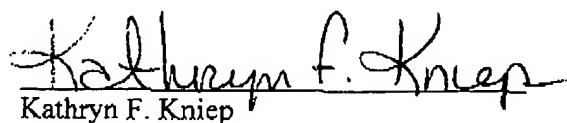


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Certificate of Facsimile

I hereby certify that the foregoing amendment and its mentioned enclosures were sent by facsimile to: Commissioner for Patents at 571-273-8300 on March 16, 2006.

  
Kathryn F. Kniep